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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,554	10/31/2000	Katsumi Nihei	Q61559	7384

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EXAMINER
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USTARIS, JOSEPH G

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/699,554

Applicant(s)

NIHEI, KATSUMI

Examiner

Joseph G. Ustaris

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-13 is/are rejected.
- 7) ☒ Claim(s) 5-7 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment dated 26 April 2005 in application 09/699,554. Claims 1-14 are pending. Claim 8 is amended.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 April 2005 has been entered.

The objection to claim 8 is now withdrawn in view of the amendments.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 9, 11, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond et al. (US006698020B1).

Regarding claim 1, Zigmond et al. (Zigmond) discloses a system and method for selecting and inserting advertisements or "an advertisement method for presenting advertisement data, transmitted by broadcasting, to users" (See Figs. 3-5). At the household or "reception end" is a WebTV box or "receiver" that is able to set "selection standards" for the user. The WebTV box includes an ad insertion device where it stores viewer and system information that is used to select advertisements (See Fig. 5, element 82). The viewer and system information defines "selection standard" such as "receive time, a receive position, and preference of the user" (See column 10 lines 47-63). The system then uses the "selection standards" to filter or "select" advertisements that meet the "selection standards" and proceeds to store the filtered advertisements in an advertisement repository or "advertisement database" (See Fig 5, elements 82, 83, 84, and 86; column 15 lines 17-23). The filtered advertisements within the advertisements repository are inherently "assigned an evaluation value" wherein the filtered advertisements meets the "selection standards" of what the viewer wishes to receive, i.e. the viewer wishes to receive advertisements that meet the viewer's local time or "reproduction time", the viewer's geographical location or "reproduction position", and the viewer's interests or "user preferences" (See column 10 lines 47-63). Any other advertisements that do not meet the "selection standards" are not stored (See column 15 lines 17-23), thus having no "evaluation value". The filtered advertisements are then "extracted" from the repository and presented to the viewer "in the order of highest evaluation value", wherein the filtered advertisements have the "highest evaluation value" for meeting the "selection standards" than the advertisements that weren't stored

because those advertisements did not meet the "selection standards" (See Fig. 5; column 12 lines 33-43).

Regarding claim 2, the advertisements have data "representing a period of an advertisement", wherein the advertisement is only selected, stored, and displayed if it meets the "selection standards" (See column 13 lines 59-67).

Regarding claim 3, the advertisements have data "representing the position of the location of the advertisement target", wherein the advertisement is only selected, stored, and displayed if it meets the "selection standards" (See column 14 lines 49-58).

Claim 9 contains the limitations of claim 1 and 8 (wherein the WebTV performs the functions of the "advertisement receiving section" (See Fig. 5, AD Delivery), "received advertisement database" (See Fig. 5, Advertisement Repository), "time, position, and preference obtaining sections" as well as the "advertisement storage processing section" (See Fig. 5, viewer and system information; column 10 lines 47-63), "advertisement extracting section" (See Fig. 5), and the "advertisement presentation section" (See Fig. 5, display)) and is analyzed as previously discussed with respect to those claims. Furthermore, the advertisements are transmitted by content providers or various other AD sources or "advertisement transmitters" (See Figs. 3 and 7). The content providers and AD source have "transmission advertisement databases" (See Fig. 3 and 7, AD) and inherently have "advertisement obtaining sections" and "advertisement transmitting section" in order to successfully deliver the advertisements to the WebTV box or receiver.

Claim 11 contains the limitations of claims 1 and 9 (wherein the WebTV is the "advertisement receiver") and is analyzed as previously discussed with respect to those claims.

Claim 12 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. Furthermore, Zigmond discloses that the advertisement system discussed in claim 1 may also be embodied as a computer program product on a computer-usable storage medium (See column 6 lines 48-67).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US006698020B1) in view of Hendricks et al. (US006408437B1).

Claim 4 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. However, Zigmond does not disclose a method where the "selection standards" can store key words that are and are not of interest to the user.

Hendricks et al. (Hendricks) discloses a set top terminal that receives programs or "advertisements" and is able to search through programs that contain key words, which are and are not of interest to the user. The key words can be stored within a

downloaded thesaurus. Any programs that contain key words that are not of interest to the user are excluded (See column 31 lines 5-10 and column 32 lines 42-51).

Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the viewer and system information and AD selection criteria disclosed by Zigmond to be able to store key words that are and are not of interest to the user, as taught by Hendricks, in order to provide a more accurate filtering process when searching through programs or "advertisements".

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US006698020B1) in view of Rakavy et al. (US006317789B1).

Claim 10 contains the limitations of claim 9 and is analyzed as previously discussed with respect to that claim. However, Zigmond does not disclose a method where the advertisements that are expired and that have been displayed a certain number of times are deleted from the local cache of the mobile web client.

Rakavy et al. discloses an Advertisement Killer or "advertisement deletion processing" that purges advertisements that have been stored for a certain time or "present time outside said period" and advertisements that have been displayed a number of times or "presented a number of times equal to said number" (See column 12 lines 60-67). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the advertisement system disclosed by Zigmond to include an Advertisement Killer, as taught by Rakavy, in order to efficiently

use the repository or "advertisement database" by freeing up more available space for newer advertisements.

Claims 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US006698020B1) in view of Seth-Smith et al. (4,866,770).

Claim 8 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. Furthermore, Zigmond discloses a "plurality of advertisement sections" (See Fig. 2A, group of ADS 20). However, Zigmond does not disclose that each "advertisement section" is repeated thus causing the same "sponsor advertisements" to be repeated in transmission.

Seth-Smith et al. (Seth-Smith) discloses a system and method for communicating video, audio, and data to various clients. Seth-Smith discloses that each data packet is repeated 5 times in a row during transmission or each "advertisement section" is repeated (See Fig. 8; column 15 lines 1-20). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the "advertisement sections" disclosed by Zigmond to be repeated, as taught by Seth-Smith, in order to ensure that the data or "advertisements" are successfully received at the user's end of the system.

Claim 13 contains the limitations of claims 8 and 9 and is analyzed as previously discussed with respect to those claims.



***Allowable Subject Matter***

4. Claims 5-7 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 5-7, the prior art of record fails to show or fairly suggest assigning higher and lower “evaluation values” based on how well the advertisements meet the “selection standards”.

Regarding claim 14, the prior art of record fails to show or fairly suggest an equation “e” to obtain an “evaluation value”.

***Response to Arguments***

5. Applicant's arguments filed 26 April 2005 have been fully considered but they are not persuasive. The following arguments have been restated from the Advisory Action dated 20 May 2005.

Applicant argues with respect to claims 1, 9, 11, and 12 that Zigmond fails to suggest assigning an evaluation value to the stored advertisements based on a reproduction time, a reproduction position, and a preference of a user and presenting the advertisements to the user in order of highest evaluation value. Applicant further extends these arguments to claims 4, 10, and 13. However, Zigmond does disclose selecting advertisements that meet the “selection standards” of what the viewer wishes to receive and view, i.e. the viewer wishes to receive advertisements that meet the viewer's local time or “reproduction time”, the viewer's geographical location or

“reproduction position”, and the viewer’s interests or “user preferences” (See column 10 lines 47-63 and column 12 lines 33-43), from the advertisement repository (See Fig. 5, element 86) where the advertisements are stored. The advertisements stored in the advertisement repository are “assigned an evaluation value” by the viewer, wherein the viewer prefers to receive and view the advertisements stored in the advertisement repository because they have more “value” to the viewer. Furthermore, the advertisements stored in the advertisement repository are presented to the viewer, wherein the advertisements within the advertisement repository have the “highest evaluation” compared to the advertisements that didn’t get stored because they did not meet the viewers selection standards or has less “value” to the user.

Applicant further argues with respect to claim 13 that Zigmond in view of Seth-Smith fails to disclose a plurality of advertisement sections, each comprising the same plurality of sponsors advertisements, such that each sponsor advertisement is repeated in each of the plurality of advertisement sections. However, Zigmond discloses a “plurality of advertisement sections” (See Fig. 2a, group of ADS 20). Seth-Smith discloses a method for repeating transmissions of data packets. The combination of Zigmond in view of Seth-Smith allows the “advertisement sections” disclosed by Zigmond to be repeated. For example, Fig. 2a of Zigmond discloses an “advertisement section” (e.g. 20, 20, 20, 28). Seth-Smith suggests repeating the transmission of this “advertisement section” (e.g. 20, 20, 20, 28, 20, 20, 20, 28, ...). Therefore, Zigmond in view of Seth-Smith does meet the limitations of claim 13.

Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### **Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph G. Ustaris whose telephone number is 571-272-7383. The examiner can normally be reached on M-F 7:30-5PM; Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JGU  
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